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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/807,675

07/09/2001

Nicholas Paul Elliott

JHN-5055-2

2251

23117 7590 05/25/2007

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EXAMINER

KLIMACH, PAULA W

ART UNIT

PAPER NUMBER

2135

MAIL DATE

DELIVERY MODE

05/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/807,675

Applicant(s)

ELLIOTT ET AL.

Examiner

Paula W. Klimach

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed on 03/12/07. The amendment filed on 03/12/07 have been entered and made of record. Therefore, presently pending claims are 1-10 and 15-17.

Response to Arguments

Applicant's arguments filed 03/12/07 have been fully considered and have not been found persuasive because of the reason stated below.

The applicant argued that Doljack is concerned with "a method of verifying the authenticity of products without accessing an offsite master..." whereas in contrast the preset invention uses an offsite decryption algorithm to compare information derived from product packaging with other data to determine authenticity of the product. This is not found persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the present invention uses an offsite decryption algorithm to compare information derived from product packaging with other data to determine authenticity of the product) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant teaches correctly that Doljack puts a combination code on the packaging. The combination code includes random and non-random data and is encrypted before being marked on the packaging. This is persuasive and correct. However the applicant argues further

Art Unit: 2135

that the above method of marking products is in direct contrast to the marking method recited in claim 7 which recites that "public data" be applied to the goods and a "security code" be applied to the goods. The applicant argues further that the security code of the present invention is derived from the public data "by means of a predetermined encryption algorithm." This is not persuasive. The combination code disclosed by the applicant is a combination of two forms of data, random and non-random, as disclosed by the applicant. The combination that corresponds to the security code and the public data corresponds to the non-random data. The non-random data is public since it is easily recognizable such as a trade name (column 8 lines 24-27). The trade name is information that is provided on labels, therefore the public data is applied to the goods. The public data is encrypted using the private key of the manufacturer and by a predetermined encryption algorithm of the public key cryptosystem. Then the encrypted public data is applied to the goods and the private data (random code) is kept by the verifier (Fig. 4) for verification.

The applicant argues the Doljack does not teach marking goods with a security code derived from public data on the goods. This is not found persuasive. In Fig. 1 and the arguments given above show that Doljack does in fact teach marking goods with a security code derived from public data on the goods.

The applicant argues further that Doljack fails to disclose goods having public data and a security code applied thereto. It fails to disclose the security code having been derived by means of a predetermined encryption algorithm by encrypting said public data, it fails to disclose generating a list of verification codes by re-encryption said public data and one of said plurality of private data sets and it fails to disclose comparing said security code with said list of

Art Unit: 2135

verification codes. This is not found persuasive. As discussed above, Doljack does in fact teach goods having public data and a security code applied thereto a security code having been derived by means of a predetermined encryption algorithm by encrypting said public data. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., generating a list of verification codes by re-encryption (emphasis added) said public data and one of said plurality of private data sets) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Doljack further discloses and it fails to disclose comparing said security code with said list of verification codes (column 9 lines 9-32).

The applicant argues further that Doljack fails to disclose a processor configured to generate a list of verification codes which are generated by said predetermined encryption algorithm by encrypting said public data and one of said plurality of private data sets. The applicant then argues that Doljack fails to disclose the process of comparing the security code applied to the goods with the list of verification codes to assess the authenticity of the goods. This is not found persuasive. The system of Doljack does teach a processor configured to generate a list (master database) of verification codes (valid codes) which are generated by said predetermined encryption algorithm by encrypting said public data and one of said plurality of private data sets (column 9 lines 33-50).

Finally the applicant argued Moore does not suggest a security code derived from public data also printed on goods or a processor to generate verification codes from the printed public

Art Unit: 2135

data. This is not found persuasive. As discussed above, Doljack discloses a security code derived from public data also printed on goods or a processor to generate verification codes from the printed public data.

The examiner asserts that Doljack does teach or suggest the subject matter broadly recited in independent Claims. Dependent Claims are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this office action. Accordingly, rejections for claims are respectfully maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7-8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Doljack (6,442,276).

In reference to claim 7, Doljack discloses a method for verifying the authenticity of goods (Abstract). The method includes applying public data to the goods for use in a subsequent verification process (column 8 line 40-67), and applying a security code to the goods (column 8 line 40-67), said security code having been derived by means of a predetermined encryption algorithm by encrypting said public data applied to the goods and one of a plurality of private data sets held by a verifier (column 8 lines 15-61).

In reference to claim 8 wherein the public data includes a batch number (column 5 line 67 to column 6 line 5 in combination with column 8 lines 15-20). The products as suggested in claim 1 are made in large number and therefore the random number for the product is the batch number.

In reference to claim 10 Doljack discloses a system wherein said public data and security code is incorporated into the design printed onto the goods as reversed out characters, blends or tints (Fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected 35 U.S.C. 103(a) as being unpatentable over Doljack (6,442,276B1).

Although Doljack discloses examples of data that may be added to the public data, Doljack does not expressly disclose including data information.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add date information to the code in the system of Doljack. One of ordinary skill in the art would have been motivated to do this because the date may be used to determine the time period that the data was valid and therefore reduce counterfeiting.

Claims 1, 3-6, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doljack (6,442,276 B1) in view of Moore (5,895,073).

In reference to claims 1, 15-17, Doljack discloses a method for verifying the authenticity of goods (Abstract). The method includes generating a list of verification codes (Figure 4), each of said verification codes being generated by said predetermined encryption algorithm by encrypting said public data and one of said plurality of private data sets (column 8 lines 15-50), wherein the private data sets are held by a verifier (column 8 lines 28). The system is finally used to comparing said security code applied to the goods with said list of verification codes to assess the authenticity of goods (Fig. 3).

The system of Doljack does not expressly disclose sending a request for verification although the system does indicate the local computer is used to read the code and send it off for verification.

Moore discloses a system and method of marking goods for authentication (abstract). The method includes receiving a request for verification (column 5 lines 15-19 in combination with column 9 lines 15-21). Downloading the value is a request for verification.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to send a request to verify the product as in Moore in the system of Doljack. One of ordinary skill in the art would have been motivated to do this because it would enable the system to be a distributed system and therefore spread the information necessary for the system to other systems that are not necessarily in the same location which makes a cheaper system by being able to share central systems.

In reference to claim 3 wherein the public data includes a batch number (column 5 line 67 to column 6 line 5 in combination with column 8 lines 15-20). The products as suggested in claim 1 are made in large number and therefore the random number for the product is the batch number.

In reference to claim 4, wherein the public data includes date information.

Although Doljack discloses examples of data that may be added to the public data, Doljack does not expressly disclose including data information. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add date information to the code in the system of Doljack. One of ordinary skill in the art would have been motivated to do this because the date may be used to determine the time period that the data was valid and therefore reduce counterfeiting.

In reference to claim 5, wherein the private data includes an item number.

Although Doljack discloses examples of data that may be added to the public data, Doljack does not expressly disclose including the item number.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add item number to the code in the system of Doljack. One of ordinary skill in the art would have been motivated to do this because the date may be used to determine the time period that the data was valid and therefore reduce counterfeiting.

In reference to claim 6 Doljack discloses a system wherein said public data and security code is incorporated into the design printed onto the goods as reversed out characters, blends or tints (Fig. 1).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doljack in view of Moore as applied to claim 1 above, and further in view of Tran (5,864,665).

Doljack does not disclose a system wherein the verifier maintains a log of requests for verification and, upon receiving a request for verification, compares the public data applied to the goods with the data held in the log to assess the authenticity of goods.

Tran discloses a method of auditing login activity (abstract), where login activity is used to verify that users are who they say they are, by maintaining a record of valid login (column 7 lines 54-60 and column 8 lines 44-47). This information may generally used for verification upon receiving a request for verification, compares the public data applied to the goods with the data held in the log to assess the authenticity of goods.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to maintain a log of verification requests as in Tran in the system of Doljack. One of ordinary skill in the art would have been motivated to do this because the log would provide a record of the goods needing verification.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 2135

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W. Klimach whose telephone number is (571) 272-3854. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PWK

Thursday, May 24, 2007


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